

## REMARKS

### A. Introduction

The remarks herein are responsive to the Office Action mailed on November 22, 2006. Claims 1-57 are currently pending. The Examiner has rejected Claims 1-5, 8-15 and 38-57. Applicant has amended Claims 1, 12, 43, 48, and 53 in this response. Applicant would like to thank the Examiner for allowing Claims 18-37, and for finding allowable subject matter in Claims 6, 7, 16, and 17.

### B. Claim Amendments

Claim 1 has been amended to recite *inter alia* that the ankle plate being not in direct contact with the foot plate. Support for this amendment can be found at least in paragraphs [0090] and [0091], and in FIG. 8 of the originally filed specification. Therefore, Applicant submits that no new matter has been entered by way of this amendment.

Claim 12 has been amended to recite *inter alia* that the ankle block comprises substantially the sole connection between the foot plate and the ankle plate. Support for this amendment can be found at least in paragraphs [0090] and [0091], and in FIG. 8 of the originally filed specification. Therefore, Applicant submits that no new matter has been entered by way of this amendment.

Claim 43 has been amended to recite *inter alia* that the length of the fore ankle block, as measured in a fore-to-aft direction, is greater than a length of the aft ankle block. Applicant submits there is now proper antecedent support for the limitation "aft ankle block," and that no new matter has been entered by way of this amendment.

Claim 48 has been amended to recite *inter alia* that the upper ankle element being not in direct contact with the lower foot element. Support for this amendment can be found at least in paragraphs [0090] and [0091], and in FIG. 8 of the originally filed specification. Therefore, Applicant submits that no new matter has been entered by way of this amendment.

Claim 53 has been amended to recite *inter alia* that the aft ankle block and the fore ankle block comprise substantially the sole connection between the ankle element and the foot element. Support for this amendment can be found at least in paragraphs [0090] and [0091], and in FIG. 8

of the originally filed specification. Therefore, Applicant submits that no new matter has been entered by way of this amendment.

C. Claim Rejections Under 35 U.S.C. § 112

Claim 43 is rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicant respectfully submits that Claim 43 has been amended to provide proper antecedent basis for the limitation "aft ankle block," and therefore Applicant requests that this rejection be withdrawn.

Claim 42 is rejected under 35 U.S.C. § 112 as lacking sufficient antecedent basis for the limitation "rear ankle block." Applicant respectfully submits that Claim 42 does not recite a "rear ankle block" limitation, and thus, Applicant requests that this rejection be withdrawn.

D. Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-5, 8, 11-15, 48, and 50-57 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,181,932 to Phillips ('932 patent).

Independent Claim 1 has been amended to recite that the ankle plate being not in direct contact with the foot plate. Applicant respectfully submits that the '932 patent does not disclose, teach or suggest *inter alia* that the ankle plate being not in direct contact with the foot plate. Instead, the '932 patent discloses "a foot portion 12 and an ankle portion 14 operatively and demountably connected to each other by bolt and nut combinations 16 associated with loadtransmitting metallic plates 17." See col. 4, ln. 49-54 (emphasis added). Therefore, the foot portion 12 and the ankle portion 14, as disclosed in the '932 patent, are in direct contact with each other, as is clearly shown in FIG. 1 of the '932 patent. Thus, Applicant respectfully submits that the '932 patent fails to teach all the limitations of Claim 1 and therefore, Claim 1 is allowable over the cited art. Claims 2-5, 8, and 11 depend, either directly or indirectly, from Claim 1, and are therefore allowable not only because each depends from an allowable base claim but also because each claim recites a unique combination of features not taught or suggested by the cited art.

Independent Claim 12 has been amended to recite that the ankle block comprises substantially the sole means of connection between the foot plate and the ankle plate. Applicant

respectfully submits that the '932 patent does not disclose, teach or suggest *inter alia* that the ankle block comprises substantially the sole connection between the foot plate and the ankle plate. Instead, the '932 patent discloses "a foot portion 12 and an ankle portion 14 operatively and demountably *connected to each other by bolt and nut combinations 16* associated with loadtransmitting metallic plates 17." See col. 4, ln. 49-54 (emphasis added). Therefore, the bolt and nut combinations 16, as disclosed in the '932 patent, provide an additional connection between the foot portion 12 and the ankle portion 14, as is clearly shown in FIG. 1 of the '932 patent. Thus, Applicant respectfully submits that the '932 patent fails to teach all the limitations of Claim 12 and therefore, Claim 12 is allowable over the cited art. Claims 13-15 depend, either directly or indirectly, from Claim 12, and are therefore allowable not only because each depends from an allowable base claim but also because each claim recites a unique combination of features not taught or suggested by the cited art.

Independent Claim 48 has been amended to recite that the upper ankle element being not in direct contact with the lower foot element. Applicant respectfully submits that the '932 patent does not disclose, teach or suggest *inter alia* that the upper ankle element being not in direct contact with the lower foot element. Instead, the '932 patent discloses "a foot portion 12 and an ankle portion 14 operatively and demountably *connected to each other by bolt and nut combinations 16* associated with loadtransmitting metallic plates 17." See col. 4, ln. 49-54 (emphasis added). Therefore, the foot portion 12 and the ankle portion 14, as disclosed in the '932 patent, are in direct contact with each other, as is clearly shown in FIG. 1 of the '932 patent. Thus, Applicant respectfully submits that the '932 patent fails to teach all the limitations of Claim 48 and therefore, Claim 48 is allowable over the cited art. Claims 50-52 depend directly from Claim 48, and are therefore allowable not only because each depends from an allowable base claim but also because each claim recites a unique combination of features not taught or suggested by the cited art.

Independent Claim 53 has been amended to recite that the aft ankle block and the fore ankle block comprise substantially the sole connection between the ankle element and the foot element. Applicant respectfully submits that the '932 patent does not disclose, teach or suggest *inter alia* that the aft ankle block and the fore ankle block comprise substantially the sole connection between the ankle element and the foot element. Instead, the '932 patent discloses "a

foot portion 12 and an ankle portion 14 operatively and demountably *connected to each other by bolt and nut combinations 16* associated with loadtransmitting metallic plates 17.” See col. 4, ln. 49-54 (emphasis added). Therefore, the bolt and nut combinations 16, as disclosed in the ’932 patent, provide an additional connection between the foot portion 12 and the ankle portion 14, as is clearly shown in FIG. 1 of the ’932 patent. Thus, Applicant respectfully submits that the ’932 patent fails to teach all the limitations of Claim 53 and therefore, Claim 53 is allowable over the cited art. Claims 54-57 depend directly from Claim 53, and are therefore allowable not only because each depends from an allowable base claim but also because each claim recites a unique combination of features not taught or suggested by the cited art.

E. Double Patenting

Claims 1-15, 38-42, 49, and 54 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-18 of U.S. Patent Application No. 10/940,174 to Phillips in view of U.S. Patent No. 6,206,934 to Phillips (’934 patent).

1. Double Patenting Rejection Improper – Secondary Reference Not Prior Art

The MPEP § 804 II.B.1. states a double patent rejection of the obviousness-type, if not based on an anticipation rationale, is “analogous to a failure to meet the nonobviousness requirement of 35 U.S.C. § 103 except that the patent *principally* underlying the double patenting rejection is not considered prior art,” and cites to *In re Braithwaite*, 379 F.2d 594 (CCPA 1967). Applicant submits that the double patenting rejection is improper because, unlike in *Braithwaite*, here the principal reference underlying the rejection and the secondary reference are not prior art whereas in *Braithwaite* the patent principally underlying the rejection was not prior art while the secondary reference was prior art. The court stated, “We regard this as an obviousness-type double patenting situation, that is, the rejection is on the ground that the difference between what is claimed here and what is claimed in the patent to *Braithwaite* is only such a difference or modification as would be obvious to those of ordinary skill in the art *in view of the prior art*.” *Id.* at 600 (emphasis added).

Here the Examiner’s rejection is not a comparison of the claimed invention to what is claimed in the cited reference *in view of the prior art* because the secondary reference cited by the Examiner does not constitute prior art under 35 U.S.C. § 102. For example, Applicant

respectfully submits that the '934 patent does not qualify as prior art under 35 U.S.C. § 102(e) because the invention was not described in a patent granted on an application for patent by *another* filed in the United States before the invention by the applicant for patent. In other words, the inventor of the present application is the same inventor of the '934 patent. Further, Applicant respectfully submits that the '934 patent does not qualify as prior art under 35 U.S.C. §§ 102(a) or 102(b) because the '934 patent issued on March 27, 2001, after the October 26, 2000 filing date of parent Application Serial No. 09/698,489. Although Applicant believes that the claims rejected may be entitled to an earlier priority date than the October 26, 2000 priority date, for the purposes of determining whether the '934 patent is prior art, Applicant submits that it is sufficient to establish that the '934 patent is not prior art with respect to the October 26, 2000 date.

Therefore, Applicant respectfully submits that the Examiner has not established an adequate or proper double patenting rejection, and thus, Applicant submits that Claims 1-15, 38-42, 49, and 54 are allowable.

2. Double Patenting Rejection Must Be Based on the Claims

Additionally, MPEP § 804 III. states, "One significant difference is that a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an anticipation or obviousness rejection based on the same patent under 35 U.S.C. 102(e) / 103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent," citing *In re Bowers*, 359 F.2d 886 (CCPA 1966). Applicant respectfully submits that the Examiner has ventured beyond a comparison of the claims in the cited reference because, as acknowledged by the Examiner, nowhere do the claims in the cited reference recite "a cantilevered heel portion."

With reference to Claims 38-42, 49 and 54, Applicant respectfully submits that the Examiner has again ventured beyond a comparison of the claims in the cited reference because nowhere do the claims in the cited reference recite, *inter alia*, that the aft ankle block is spaced from the fore ankle block. Further, with reference to Claim 38, nowhere do the claims in the cited reference recite, *inter alia*, that a rear portion of the ankle element is spaced a greater distance from the foot element than a front portion of the ankle element is spaced from the foot element. With reference to Claim 49, nowhere do the claims in the cited reference recite, *inter*

*alia*, that the thickness of the foot element remains substantially constant along any line that extends in a medial/lateral direction. Additionally, with reference to Claim 54, nowhere do the claims in the cited reference recite, *inter alia*, that at all points forward of the fore ankle block, the foot element includes a substantially smooth upper surface.

It appears that the Examiner has improperly relied on the references for all that they fairly disclose to one of ordinary skill in the art, regardless of what is claimed. Therefore, Applicant respectfully submits that the Examiner has not established an adequate or proper double patenting rejection, and thus, Applicant submits that Claims 38-42, 49 and 54 are allowable.

Further, MPEP § 804 II.B.1. states, "Any obviousness-type double patenting rejection should make clear, among other things, the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent." In the rejection, the Examiner did not set forth reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims at issue would have been an obvious variation of the invention defined in the claims of the cited references. In this instance, the Examiner's reasoning is especially required given that certain claim limitations as set forth above appear to be expressly absent from the claims of the cited references. Moreover, the Examiner did not present any suggestion or motivation for modifying or combining the references cited by the examiner. Again, Applicant respectfully submits that the Examiner has not established an adequate or proper double patenting rejection.

F. Conclusion

Applicant respectfully submits that the claims are in condition for allowance. Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence or estoppel is or should be implied thereby; such amendments are made only to

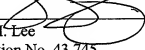
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expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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